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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,048	07/25/2000	Charles G. Fisher	84417.4001	6906

28765 7590 04/07/2004

WINSTON & STRAWN  
PATENT DEPARTMENT  
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WASHINGTON, DC 20005-3502

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/625,048

Applicant(s)

FISHER ET AL.

Examiner

Narayanswamy Subramanian

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*ML*

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to applicant's communications filed on December 3, 2003. Addition of new claims 21-23 has been entered. Claims 1-23 are currently pending. New claims 21-23 are subject to restriction as discussed below and have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. Applicant's arguments with reference to rejection of claims 1-13 under 35 U.S.C. 112, second paragraph are persuasive and hence the Examiner withdraws this rejection. Claims 1-20 have been re-examined. The response to amendment, rejections and response to arguments are stated below.

#### ***Response to Amendment***

2. Newly submitted claims 21-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The claims 1-20 that were examined in the first office action are drawn to a system and method for administering variable annuity contracts, said system comprising: memory means for storing data relating to at least one variable annuity contract of a contract-owner, said at least one variable annuity contract having an associated bonus investment credit percentage, associated withdrawal charge percentages for each of a plurality of contract years, each withdrawal charge percentage being less than or equal to said bonus investment credit percentage, and an asset-based compensation percentage constant over all contract years, said data including said bonus investment credit percentage and a premium amount paid by said contract-owner in a first contract year; and processing means operatively coupled to said memory means configured to

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read said bonus investment credit percentage and said premium amount from said memory means and calculate a bonus investment credit by multiplying said premium amount by said bonus investment credit percentage.

The new claims 21-23 are drawn to a method of administering a variable annuity contract, said method comprising: issuing a variable annuity contract; structuring seller compensation for the variable annuity contract on an asset-basis to be paid incrementally; assigning a bonus investment credit for the variable annuity contract; limiting withdrawal charges of the variable annuity contract to less than or equal to the bonus investment credit; and processing the issued variable annuity contract with the structured seller compensation, the assigned bonus investment credit, and limited withdrawal charges. Clearly the limitations present in claims 21-23 such as “structuring seller compensation for the variable annuity contract on an asset-basis to be paid incrementally; assigning a bonus investment credit for the variable annuity contract; limiting withdrawal charges of the variable annuity contract to less than or equal to the bonus investment credit” are not present in the system and method of claims 1-20, making the two inventions distinct and independent.

3. Because these inventions are distinct for the reasons given above and the search required for claims 1-20 is different from that required for new claims 21-23, restriction for examination purposes as indicated is proper even though the two inventions are classified in the same class and sub-class. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-23 are withdrawn from consideration as being directed to

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a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Applicants in replying to this office action are respectfully advised to cancel the non-elected claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooperstein (US Patent 5,893,071) as discussed in paragraph 5 the last office action (Paper No. 6)

***Response to Arguments***

6. With reference to Applicant's arguments regarding claims 1 and 14, that the prior art and the known and conventional practice in the relevant art does not teach or disclose a system or method that includes the combination of "an associated bonus investment credit percentage, associated withdrawal charge percentages for each of a plurality of contract years, each withdrawal charge percentage being less than or equal to said bonus investment credit percentage, and an asset-based compensation percentage constant over all contract years", the examiner would like to point out that data stored in the memory of the system namely "each withdrawal charge percentage being less than or equal to said bonus investment credit percentage, and an asset-based compensation percentage constant over all contract years" are merely descriptive and not functional. There is nothing in these claims that will make the system or the method work differently if "each withdrawal charge percentage is greater than said bonus

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investment credit percentage, and an asset-based compensation percentage non-constant over all contract years". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicants' other arguments regarding the rejections under 35 U.S.C. 103(a) cited in the last office action have been considered but are non-persuasive. Hence the rejections are maintained.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian

April 1, 2004

Richard Weisberger  
Primary Examiner

**RICHARD WEISBERGER**  
**PRIMARY EXAMINER**